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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,741	03/23/2000	Thomas M. D'Angelo	P-3009.2	1020

7590

04/14/2003

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EXAMINER

STAICOVICI, STEFAN

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 04/14/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/533,741

Applicant(s)

THOMAS M. D'ANGELO

Examiner

Stefan Staicovici

Art Unit

1732

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires three months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1,3-6,11,12,14,15 and 17-22.

Claim(s) withdrawn from consideration: 23-26.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attachment

ATTACHMENT TO ADVISORY ACTION

Amendment

1. Applicants' After-Final amendment filed April 9, 2003 (Paper No.9) will not be entered since the proposed amendments raise new issues that would require further consideration and also, since the proposed amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Specifically, the newly added limitation in claim 1, line 2, of a molded part "which is a flexible boot or tube for a vehicle or industrial equipment" introduces subject matter which has not been previously presented and as such would require further consideration.

Claims 1, 3-6, 11-12, 14-15 and 17-26 are pending in the instant application.

Response to Remarks

2. Applicant's arguments filed January 24, 2002 (Paper No.10) have been fully considered.

The amendments to the Abstract and the claims would have been entered if the After-Final amendment filed April 9, 2003 (Paper No.9) had been entered.

Applicant argues that the art of record does not teach or suggest a molding process for making "boots for vehicular purposes." Further, Applicant argues that "Applicant's devices are utilized to secure one portion of a vehicle or a piece of equipment to another portion and to facilitate the movement as may be necessary in the installation and/or operation of the vehicle or equipment" (see pages 9-10 of the After-Final amendment filed April 9, 2003). However, as

shown above, Applicant's arguments are drawn to a newly submitted limitation that would raise new issues and require further consideration. Furthermore, it should be noted that recitation of the intended use of the claimed process must result in a structural difference between the claimed process and the prior art in order to patentably distinguish the claimed invention from the prior art. It should be noted that in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

Applicant argues that the "Applicant molds the desired product," whereas the "patentees mold a product *and then* attach them together" (emphasis added) (see page 13 of the of the After-Final amendment filed April 9, 2003). However, under MPEP §2111.03, the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997).

In response to applicant's argument that there is no suggestion to combine the references, as stated on pages 10-11 of the After-Final amendment filed April 9, 2003, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Maroschak ('025) teaches a process for continuously molding corrugated parts including,

providing an extruded soft tube of thermoplastic material and a plurality of die blocks defining mold halves, advancing said soft extruded tube zone in a blow-molding machine where said plurality of die blocks continuously form an intermediate corrugated portion (body) between non-corrugated portions (collar). Lupke ('398) teaches a process for continuously forming a ribbed tube (convoluted) including a ribbed portion and end segments having a differing geometry by using a plurality of die blocks of differing geometries in a continuous blow molding machine. It is submitted that die block (52) creates a portion "A", die block (52a) creates a portion "B" and die block (52b) creates a portion "C" (see Figure 9). Therefore, it would have been obvious for one of ordinary skill in the art to have provided die blocks having differing geometries as taught by Lupke ('398) to form end segments of a differing geometry in the process of Maroschak ('025), because Lupke ('398) specifically teaches that such end segments having differing geometries reduce the complexity of the joining process of the resulting tubes, hence improving product quality and also because both references teach similar processes and end-products. Hence, the motivation to combine is found in the teaching of Lupke ('398).

It should be noted that under MPEP §2144, it "is *not necessary* that the prior art suggest the combination to achieve the *same advantage* or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972)." Further, MPEP §2144 states that it "is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention."

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino, can be reached at (703) 308-3853. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD



Primary Examiner

4/11/03

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April 11, 2003